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In re Application of:

Aman, Craig S.

Serial No.: 09/739,357

Filed: Dec. 19, 2000

Docket: 10003506

Title: WEB ENABLED MEDICAL DEVICE
TRAINING

7/11/08

DECISION ON PETITION

This is a decision on the petition filed on Apr. 15, 2008 seeking to vacate the Office action of Jan. 29, 2008 and forward the case to the Board of Patent Appeals and Interferences for adjudication. This petition is being considered pursuant to 37 CFR § 1.181(a)(3).

The petition is dismissed.

In the petition, the petitioner requests that the Director vacate the Office action of Jan. 29, 2008 and allow the appeal to go forward to the Board of Patent Appeals and Interferences.

The record shows that:

- 1) On Jul. 13, 2007, the examiner mailed a final rejection.
- 2) On Nov. 6, 2007, the applicant filed an appeal brief appealing the claims rejected in the final rejection.
- 3) In response to the appeal brief, the examiner on Jan. 29, 2008, re-opened prosecution by adding a new reference to the rejection. The Office action was made non-final to provide the applicant an opportunity to respond to the newly found prior art reference and new grounds of rejection in accordance with M.P.E.P. § 1207.04¹.

¹ M.P.E.P. 1207.04 [R-3] Reopening of Prosecution After Appeal. The examiner may, with approval from the supervisory patent examiner, reopen prosecution to enter a new ground of rejection after appellant's brief or reply brief has been filed. The Office action containing a new ground of rejection may be made final if the new ground of rejection was (A) necessitated by amendment, or (B) based on information presented in an information disclosure statement under 37 CFR 1.97(c) where no statement under 37 CFR 1.97(e) was filed. See MPEP § 706.07(a). Any after final amendment or affidavit or other evidence that was not entered before must be entered and considered on the merits.

- 4) Apr. 15, 2008, the current petition was filed to request withdrawal of the Office action of Jan. 29, 2008 and allow the case to go forward to the Board of Appeals and Interferences.

Discussion and Analysis

A review of the last Office action mailed on Jan. 29, 2008 shows that the examiner's action with new grounds of rejection contains no error and is in full compliance with M.P.E.P. § 1207.04. The office action does not appear to be arbitrary and capricious. It is noted in the petition that the petitioner does not challenge the validity of the non-final Office action of Jan. 29, 2008. Therefore, there is no need to withdraw the Office action.

With regard to the new non-final Office action after the filing of the appeal brief, Office policy requires examiners to complete a thorough prior art search, and avoid piecemeal examination as much as possible. Regrettably, due to the late discovery of prior art, prosecution of the applicant's case has been unavoidably prolonged. Petitions to the Technology Center (TC) Director generally involve procedural errors and not issues to the merits of the case. These petitions are usually for non-appealable issues in accordance with 37 CFR § 1.181(a) (1)². Since the applied prior art involves the merits of the case, and the application of the prior art does not appear to be arbitrary and capricious, it is appropriate that the new issues generated by the newly applied prior art be properly resolved before the examiner or taken up on appeal with the Board of Patent Appeals and Interferences. Moreover, it is the Primary Examiner's duty to consider the merits of the claims as provided in MPEP § 1004. Because this matter is appealable, it does not fall within the TC Director's discretion in accordance with 37 CFR § 1.181. Under the circumstances, the requested relief for withdrawal or removal of the rejection of Jan. 29, 2008 cannot be granted by petition.

In response to this petition, petitioner is urged to respond to the rejection of Jan. 29, 2008 by filing an amendment or by filing a new appeal brief with a new notice of appeal to avoid abandonment. However, the examiner is instructed to expediently proceed with the examination of the application while also taking into consideration Office policy discouraging piece meal prosecution under M.P.E.P. § 707.07(g)³. Finally, in order to avoid further re-opening of the prosecution, the examiner is reminded to perform a complete and thorough search of prior art considering not only the claims presented, but also any subject matter the examiner reasonably

² 37 CFR § 1.181(a)(1) states: Petition may be taken to the Director: (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.

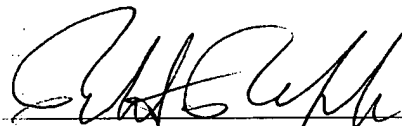
³ M.P.E.P. § 707.07(g) states: Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, how-ever, undue multiplication of references.

anticipates might be incorporated into a subsequent amendment in accordance with MPEP § 904.03⁴.

Conclusion

For the forgoing reasons, the relief requested by the petitioner will not be granted, because such relief is not the type which can be granted by petition. The application is being forwarded to the Supervisory Patent Examiner in Art Unit 3714 waiting for the applicant's response to the non-final Office action. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR §1.181. No extension of time under 37 CFR § 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR § 1.181". Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856.

PETITION DISMISSED.



Robert Olszewski, Director
Technology Center 3700

⁴ M.P.E.P. § 904.03 states in relevant part: "It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment."